

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte THOMAS SETH BELCHER and LARRY TRACE COOPER

Appeal 2007-2887
Application 10/627,440
Technology Center 3700

Decided: October 15, 2007

Before TONI R. SCHEINER, DEMETRA J. MILLS, and ERIC
GRIMES, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a gaming surface, which the Examiner has rejected for anticipation and obviousness. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification discloses “drawing surfaces for role-playing games, strategy games, and planning boards, and[,] in particular, to portable, adaptable surfaces that are compatible with dry-erase markers” (Spec. 2).

The surfaces are made up of tiles that have a grid printed on them and that interlock by various means (jigsaw puzzle-type tabs and recesses, ball-and-socket connection, etc.) (*id.* at 5). Figure 1 is reproduced below:

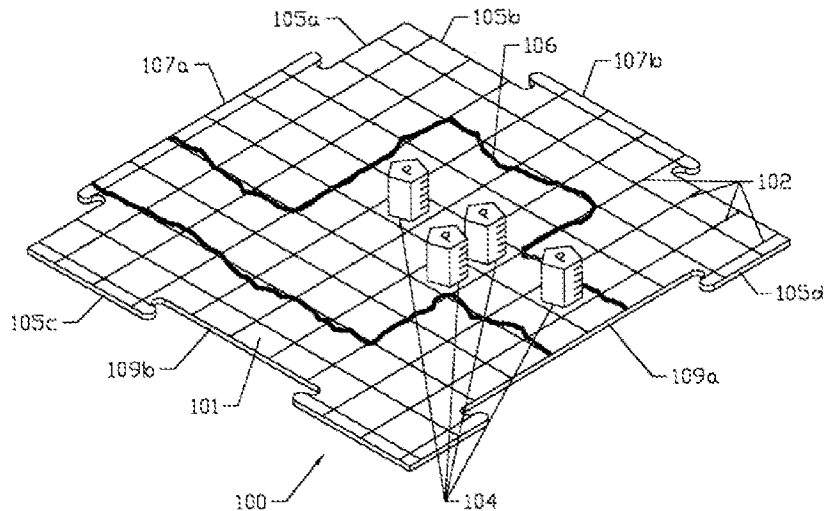


Figure 1 shows an embodiment of one of the disclosed tiles, having a square grid printed on it and jigsaw puzzle-type connectors for other tiles.

Figure 2 is reproduced below:

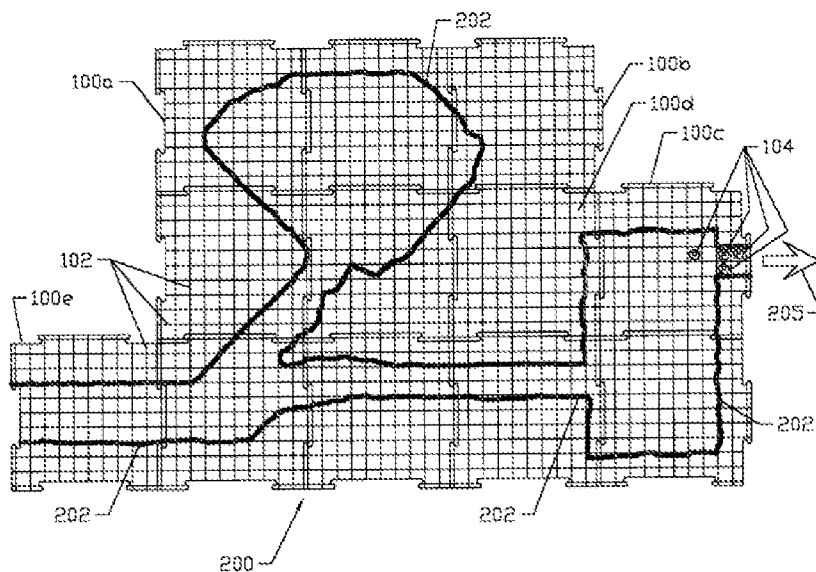


Figure 2 shows a surface made up of several of the tiles shown in Figure 1 connected together.

DISCUSSION

1. CLAIMS

Claims 1-20 are pending and on appeal. The claims subject to each rejection have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). We will focus on claim 1, which reads as follows:

1. A portable, adaptable gaming plane, said gaming plane providing an area upon which to draw erasable maps for strategy games comprising a plurality of interconnecting tiles, each of said tiles being a substantially non-flexible tile and comprising:
 - a. at least three edges comprising means for interconnecting;
 - b. a substantially non-porous surface compatible with the use of a dry-erase marker such that marks upon said surface made using said dry-erase marker are easily erased; and
 - c. a grid perceptible on said surface, said grid formed by delineations such that said delineations align with delineations forming like grids perceptible on like tiles interconnected with said tile.

2. ANTICIPATION

Claims 1-7, 9, 11-17, and 19 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bassett.¹ The Examiner finds that

Bassett teaches a gaming plane (10) having plurality of tiles (Fig. 1), tiles having at least three edges comprising means for interconnecting (Fig. 5) . . . , tiles made out of plastic material (2:2-5) are well known to be compatible with dry-erase markers, and the board providing a perception of a Cartesian grid (Fig. 1).

¹ Bassett, US 3,057,624, issued Oct. 9, 1962.

(Answer² 3.) With respect to the limitation requiring a “substantially non-porous surface compatible with the use of a dry-erase marker,” the Examiner reasons that such a surface “is inherently disclosed due to use of the plastic material in [the] Bassett reference. Plastic is a well known substantially non-porous material, commonly known and used in making game boards, and used for playing games by marking with dry-erase markers” (*id.*).

We agree with the Examiner’s reasoning and conclusion.

Appellants argue that Bassett’s disclosure of plastic tiles does not meet the limitation of claim 1 requiring a “substantially non-porous surface compatible with the use of a dry-erase marker,” because

tiles similar to those taught in the ‘624 Patent may be formed of plastic but would not possess non-porous surfaces suitable for use with dry-erase markers. *See Ward*, Col. 5, ll. 30-61. Those of ordinary skill in the art recognize that surfaces upon which dry-erase markers may be used such that marks are readily erasable are non-porous surfaces and that simple plastic, without a treatment of its surface, does not provide a proper surface for use with dry-erase markers.

(Appeal Br.³ 14.) Appellants also argue that the “surface upon which it is intended that dry-erase markers are to be used must be specifically treated in order so that marks made with such markers may be easily erased” (Reply Br. 3).

These arguments are not persuasive. Appellants’ own Specification states that a variety of materials, including some polymers that would typically be referred to as “plastic,” provide a substantially non-porous surface compatible with dry-erase markers:

² Examiner’s Answer mailed Dec. 13, 2006.

³ Revised Appeal Brief received Sept. 21, 2006.

Construction of dry-erase surfaces is well-known. They can be constructed by laminating a substrate with a polypropylene layer. In the alternative, a substrate, for example, one comprised of polystyrene, may be treated with a clear polymer sealant coating to provide a dry-erase compatible surface. . . . Lastly, certain materials may be used in the fabrication of a tile which are compatible with the use of dry-erase markers without treating or laminating of any kind.

(Spec. 6-7.) Thus, the Specification indicates that both polypropylene and “a clear polymer sealant” provide substantially non-porous surfaces compatible with dry-erase markers. The Specification also indicates that some materials are compatible with dry-erase markers without any special treatment (*id.*).

Appellants have not provided persuasive evidence that those skilled in the art would have understood Basset’s “plastic” tiles to have something other than a “substantially non-porous surface compatible with the use of a dry-erase marker.” Appellants point to column 5, lines 30-61, of Ward, but that passage does not discuss plastic materials that are or are not compatible with dry-erase markers. Appellants cite no other evidence to support their position. We conclude that a preponderance of the evidence of record supports the Examiner’s position that Basset’s “plastic” tile would inherently have a substantially non-porous surface compatible with using dry-erase markers.

Appellants also argue that Bassett “fails to disclose, expressly or otherwise, the limitation added by present Amendment of each side comprising interconnecting means so that each tile may be mutually interconnected with any other tile” (Appeal Br. 14-15).

As we understand it, Appellants' argument refers to the amendment that was originally submitted with the Appeal Brief filed August 17, 2005. That amendment would have amended claim 1 to require that each of the tiles comprise "at least three edges, *each of said at least three edges* comprising means for interconnecting" (proposed amendment in italics).

However, that amendment was filed after the Final Office action (mailed February 11, 2005). Appellants have acknowledged that "[n]o amendments have been entered since Final Rejection" (Appeal Br. 7). The Examiner has confirmed that "[n]o amendment after final has been entered" (Answer 2). Therefore, the claims as they currently stand do not require each of the edges of the tiles comprising the gaming surface of claim 1 to include means for interconnecting.

3. OBVIOUSNESS

Claims 1-20 stand rejected under 35 U.S.C. § 103 as follows:

- Claims 1-7, 9, 11-17, and 19 over Bassett and Ward;
- Claims 1-7, 9, 11-17, and 19 over Bassett, Ward, and Somerville;
- Claims 8 and 18 over Bassett, Ward, Somerville, and Grutta;
- Claims 10 and 20 over Bassett, Ward, Somerville, and Kleva.

With respect to the rejections of claims 1-7, 9, 11-17, and 19 based on Bassett and other references, we have already concluded that Bassett anticipates claim 1. We therefore affirm the rejections of claim 1 as obvious in view of Bassett in combination with Ward or Ward and Somerville:

Anticipation is the epitome of obviousness. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Claims 2-7, 9, 11-17, and 19 fall with claim 1.

Appellants argue that the references do not provide motivation to combine their teachings or disclose all of the claim limitations (Appeal Br. 17-21, Reply Br. 3-13). These arguments are unpersuasive because, for the reasons discussed above, we find that Bassett anticipates claim 1.

With respect to the rejection of claims 8 and 18 and the rejection of claims 10 and 20, the Examiner relies on Bassett (and other references) to teach the basic gaming surface of claim 1 and cites Grutta and Kleva for their disclosures of ball-and-socket and magnetic connectors, respectively. (Answer 5-6.) We agree with the Examiner that it would have been obvious to a person of ordinary skill in the art to substitute the ball-and-socket connector of Grutta or the magnetic connector of Kleva for the jigsaw puzzle-type connector of Bassett, because all of these connectors were art-known equivalents. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”); *In re Fout*, 675 F.2d 297, 301 (CCPA 1982) (“Express suggestion to substitute one equivalent for another need not be present to render such substitution obvious.”).

The rejection of claims 8 and 18 and the rejection of claims 10 and 20 were included in the Final Office action, but Appellants did not address either rejection in their Appeal Brief or Reply Brief. We therefore affirm the rejections of claims 8, 10, 18, and 20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

Appeal 2007-2887
Application 10/627,440

AFFIRMED

dm

LANIER FORD SHAVER & PAYNE P.C.
P O BOX 2087
HUNTSVILLE AL 35804